

ESTTA Tracking number: **ESTTA249932**

Filing date: **11/19/2008**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	Northern Digital Inc.
Granted to Date of previous extension	11/19/2008
Address	103 Randall Drive Waterloo, N2V 1C5 CANADA
Correspondence information	Debra Serota Attorney of Record Fish & Richardson 225 Franklin Street Boston, MA 02110 UNITED STATES serota@fr.com, tmdoctc@fr.com Phone:617 542 5070

### Applicant Information

Application No	78618710	Publication date	07/22/2008
Opposition Filing Date	11/19/2008	Opposition Period Ends	11/19/2008
Applicant	NDI MEDICAL, LLC 22901 MILLCREEK BOULEVARD, SUITE 110 CLEVELAND, OH 44122 UNITED STATES		

### Goods/Services Affected by Opposition


Class 010. First Use: 2007/01/10 First Use In Commerce: 2007/01/10 All goods and services in the class are opposed, namely: Medical devices, namely, stimulators for causing electrical neurostimulation and neuromodulation to tissue
Class 041. First Use: 2007/01/10 First Use In Commerce: 2007/01/10 All goods and services in the class are opposed, namely: Educational services, namely, organizing and conducting physician training, seminars, workshops, conferences, and classes of instruction for using systems and devices for causing electrical neurostimulation and neuromodulation to tissue

### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

### Mark Cited by Opposer as Basis for Opposition

U.S. Registration	2769520	Application Date	03/10/2000
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No.			
Registration Date	09/30/2003	Foreign Priority Date	NONE
Word Mark	NDI		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 1996/06/01 First Use In Commerce: 1996/06/01 Electronic motion measurement and position detection devices for use in industrial applications to measure the position and/or orientation of target objects, and computer software for the operation of the foregoing devices</p> <p>Class 010. First use: First Use: 1996/06/01 First Use In Commerce: 1996/06/01 Components for medical devices, namely, electronic motion measurement and position detection devices for use in medical applications to measure the position and/or orientation of analytical or therapeutic devices with respect to a patient during analytical or therapeutic procedures, for measuring motion of a living body for analysis or therapy, and computer software sold as a unit therewith for the operation of the foregoing devices</p>		

Related Proceedings	Opposition No. 91182420
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## Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/debra s serota/
Name	Debra Serota
Date	11/19/2008

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Application Serial No. 78/618710  
For the Mark NDI

NORTHERN DIGITAL INC.,  
Opposer

vs.

NDI MEDICAL, LLC  
Applicant

Opposition No.

Trademark Trial and Appeal Board  
Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513

NOTICE OF OPPOSITION

Northern Digital Inc. ("Opposer"), a corporation duly organized and existing under the laws of Canada, and having an address of 103 Randall Drive, Waterloo, Ontario, N2V 1C5, Canada, believes that it will be damaged by the registration of the mark NDI shown in the above-identified application and, having previously filed and been granted a request for an extension of time to oppose said application, hereby opposes the same.

As grounds therefore, it is alleged that:

1. Opposer is in the business of electronic motion measurement and position detection devices, which it designs, develops and sells to a number of industries, including, without limitation, the medical, industrial and scientific research industries.

2. Since at least as early as 1981, and long prior to January 10, 2007 the date NDI Medical, LLC ("Applicant") alleges to have first used the designation NDI, and long prior to any

constructive use of Applicant's designation NDI, Opposer has been, and is now, designing, developing and selling its electronic motion measurement and position detection devices under the trade name NDI. Opposer has been, and is currently, identified and recognized under the trade name NDI by the relevant industries.

3. Since at least as early as 1996, and long prior to January 10, 2007, the date Applicant alleges to have first used the designation NDI, and long prior to any constructive use of Applicant's designation NDI, Opposer adopted and began to use the trademark NDI for its electronic motion measurement and position detection devices. Opposer has been, and is currently, identified and recognized under the trademark NDI by the relevant industries.

4. The NDI trademark has been duly registered in the United States Patent and Trademark Office by Opposer for Opposer's electronic motion measurement and position detection devices. Opposer owns U.S. Registration No. 2,769,520 for NDI for industrial and medical goods, namely, electronic motion measurement and position detection devices in International Classes 9 and 10, which issued on September 30, 2003.

5. Since long prior to January 10, 2007, the date Applicant alleges to have first used the designation NDI, and long prior to any constructive use of Applicant's designation NDI, Opposer has marketed and promoted the NDI trade name and trademark in the relevant industries in connection with Opposer's electronic motion measurement and position detection devices.

6. By virtue of such marketing and promotion, together with Opposer's use of the NDI trade name and trademark and the quality of the goods designed, developed and sold under the NDI name and mark, Opposer's NDI trade name and trademark have become, and are now, known in the relevant industries.

7. Applicant, by virtue of the application herein opposed, seeks registration of the mark NDI for medical goods and services relating to the electronic stimulation of tissue in International Classes 10, 35 and 41.

8. Opposer, under its NDI trade name and trademark, designs, develops and sells electronic motion measurement and position detection devices for use in the medical industry.

9. Applicant's designation NDI is identical to Opposer's NDI trade name and NDI trademark.

10. Applicant's designation NDI so closely resembles Opposer's previously used NDI trade name that, when applied to Applicant's medical goods and/or services, it is likely to suggest a false connection or association with Opposer.

11. Applicant's designation NDI so closely resembles Opposer's previously used NDI trademark that, when applied to Applicant's medical goods and/or services, it is likely to cause confusion, to cause mistake and to deceive, with consequent injury to Opposer, the trade and the public, all in violation of Section 2(d) of the Federal Trademark Act, 15 U.S.C. § 1052.

12. Applicant's designation NDI so closely resembles Opposer's previously used NDI trade name and previously used and registered NDI trademark that, when applied to Applicant's medical goods and/or services, it is likely to cause dilution of the NDI trade name and NDI trademark, with consequent injury to Opposer, the trade and the public, all in violation of Section 43(c) of the Federal Trademark Act, as amended, 15 U.S.C. § 1125(c).


13. Opposer will be damaged by the registration sought herein by Applicant because such registration will support and assist Applicant in the confusing, misleading, and deceptive use of the designation NDI sought to be registered, and will give color of exclusive statutory rights in Applicant in violation and derogation of the prior and superior rights of Opposer.

WHEREFORE, Opposer believes that it will be damaged by registration of Applicant's designation NDI and prays that it not be allowed.

Please charge Deposit Account 06-1050, Order No. 07508-081PP2 for the filing fee for this Notice of Opposition, as well as for any other fees that may be due.

Respectfully submitted,

Dated: 11/19/08

  
Debra Serota

Fish & Richardson P.C.  
225 Franklin Street  
Boston, MA 02110  
(617) 542-5070 telephone  
(617) 542-8906 facsimile